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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,304	12/20/2001	Andreas Jagtoyen	03438.0082	8395

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EXAMINER
VERBITSKY, GAIL KAPLAN

ART UNIT	PAPER NUMBER
2859	

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/937,304	Jagtoyen
Examiner	**Art Unit**
Gail Verbitsky	2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-14 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideratio

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-4, 8-14 is/are rejected.

7) ☒ Claim(s) 5-7 is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examine

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 5/2995
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119 (a)-(d).

Specification

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Objections

3. Claims 2-3 objected to because of the following informalities:

Claims 2-3: Perhaps applicant should delete "fig. 3" from the claims in order to clearly describe the invention.

Claim 2: A) Perhaps applicant should replace "the" before "part" in line 5 with --a-- for a proper antecedent basis,

B) Perhaps applicant should insert --mechanical-- before "part" in line 6 in order to clearly describe the invention. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case, "if" in line 17 makes the claim language is confusing because it is not clear whether applicant actually claims " more then one sensor" and thus, "a multiplexer" or not. Claims 9-14 are rejected by virtue of their dependency on claim 8.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (U.S. 5438322) [hereinafter Martin] in view of Bauerschmidt et al. (U.S. 6239723B1) [hereinafter Bauerschmidt].

Martin discloses in Figs. 1-2 a device positionable in inaccessible part (mounting hole) of a moving body (bearing of a moving railroad car) to indicate the temperature of the part. The device comprises a temperature sensitive element 32, a coaxial transmission line (contact pin) 68 connecting the element to an antenna 56 and positionable in a standard bolt screwed in a mounting hole in the bearing. The antenna, as shown in Fig. 3, protrudes above the bolt.

The bolt is filled internally with a material (compression spring) and a diaphragm (flexible, stretchable heat resistance material) which keeps the element in a required position. As shown in Fig. 1, the element is arranged in a lower end of the mounting hole.

Martin does not teach that the temperature sensing element is an encapsulated SAW element.

Bauerschmidt discloses a device in the field of applicant endeavor comprising an encapsulated SAW sensor 7d to measure temperature.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the temperature sensor disclosed by Martin, with the encapsulated SAW temperature sensor, as taught by Bauerschmidt, because both of them are alternate types of temperature sensors which will perform the same function, of measuring temperature of an inaccessible moving part and transmitting it to an antenna, if one is replaced with the other.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin and Bauerschmidt as applied to claims 1-3 above, and further in view of Waters et al. (U.S. 5070706A) [hereinafter Waters].

Martin and Bauerschmidt disclose the device as stated above in paragraph 7.

They do not explicitly teach that the material is an epoxy material, as stated in claim 4.

Waters discloses a heat resistant epoxy to retain a structure in place.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Martin and Bauerschmidt, so as to make the heat resistant material epoxy, as taught by Waters, because both of them are alternate types of heat resistant material which will perform the same function, of retaining a structure in a desired position, if one is replaced with the other.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin and Bauerschmidt as applied to claims 1-3 above, and further in view of Bernstein (U.S. 5711607).

Martin and Bauerschmidt disclose the device as stated above in paragraph 7.

They do not disclose a second sensor and a second antenna associated with the second sensor (plurality of sensors), and a multiplexer.

Bernstein teaches that a plurality of temperature sensors can be used, and a multiplexor is used (switch) to switch between the sensors.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Martin and Bauerschmidt, so as to have a plurality of temperature sensors located in different positions and switched by a multiplexor, as taught by Bernstein, because, while the addition of multiple sensors to the concept of Martin and Bauerschmidt undoubtedly makes the invention more useful to determine the temperature of different moving parts at the same time, it is not the type of innovation for which a patent

monopoly is to be granted. *See In re St. Regis Paper Co. V. Bemis Co., Inc.*, 193 USPQ 8, 11 (7th Cir. 1977).

Allowable Subject Matter

10. Claims 9-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. Claims 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices.

13. Any inquiry concerning this communication should be directed to Examiner Verbitsky who can be reached at (703) 306-5473 Monday through Friday 7:30 to 4:00 ET.

Any inquiry of general nature should be directed to the Group Receptionist who can be reached at (703) 308-0956.

GKV

January 08, 2002

Gail Verbitsky, Patent Examiner, TC 2800